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File

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

MARCANTONI, P

ART UNIT

PAPER NUMBER

1755

DATE MAILED:

2
06/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/11/00 REISSUE-FILING DATE
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 28-62 is/are pending in the application.
- ☐ Of the above claim(s) 28-31 is/are withdrawn from consideration.
- ☒ Claim(s) 1-27 is/are allowed.
- ☒ Claim(s) 28-62 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☒ Claim(s) 28-31 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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Improper Presentation of Product Claims in Re-Issue Application

Claims 28-31 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The applicants indicated in their re-issue declaration by the inventor (on page 2) and by the submission of these product claims 28-31 that “Applicants failed to realize between the time of receipt of the Notice of Allowance and the time of the payment of the issue fee and issuance of the patent that the patentable subject matter of the non-elected claims had not been made the subject of a divisional continuing patent application”. In rebuttal to this, applicants should have been aware that the presentation of these product claims through this venue is improper. While the PTO empathizes with applicants with respect to their product claims since they did not file a divisional application to obtain the benefit of the parent application filing date, their inadvertance or negligence on their part to get these claims re-instated via reissue is not proper. The applicants’ presentation of these product claims which were previously canceled as a result of a restriction requirement (i.e. the product claims are non-elected and then canceled claims from the US patent to this re-issue) is an example of an error which may not be corrected by re-issue. Re-issue may not be utilized to reclaim subject matter which was non-elected in the original application. 35 USC 251 cannot be used to circumvent other statutory requirements, e.g. the

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copendency requirement of 35 USC 120 for filing divisional applications on non-elected subject matter. This also applies to broadened variations of non-elected subject matter (SEE MPEP 1402 and 1450 as well as *In re Orita*, 193 USPQ 145. Nevertheless, applicants are respectfully thus requested to cancel all product claims for the ^{reasons}~~reasons~~ cited above as their presence in the re-issue application is improper.

New Matter

Claims 32-6~~2~~ are rejected under 35 USC 251 and 35 USC 112 first paragraph on the grounds that the specification as originally filed would not appear to provide support for the invention as is now claimed.

It would appear that the changes made throughout newly submitted claims 32-61 contain new matter not supported by the original disclosure. Re-issue requires that for each amendatory change to the claims, when first submitted, including the addition of new claims, must be accompanied by an explanation of the support in the disclosure of the patent for the change (specifically the location from the original patent where support is derived for each new claim) along with any necessary additional comments on pages separate from the pages containing the amendment. See 37 CFR 1.121(b)(2)(iii). Applicants are thus respectfully requested to provide the location of support from their original patent briefly for each of claims 32-61. Upon a showing of sufficient support by applicants, it is expected that this new matter rejection will be withdrawn.

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Rejection under 35 USC 112 2nd paragraph

Claims 32-62 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

In claim 32 and 58 (a), the terms “surfactant concentration is much less than the critical micelle concentration” are relative and indefinite term. How much exactly is considered “much less” and what exactly is the critical concentration? Numerical amounts are respectfully requested in the claims.

In claim 38 a degree symbol “°” is needed between the 400 and the C (for celsius).

Claim 40 is vague, confusing and indefinite as applicants do not particularly point out and distinctly claim specifically what they mean by any one or more of the steps including spin coating, rapid evaporation, and calcination. What are the specific steps exactly needed to achieve applicants mesoporous film for each method of making? As it stands, applicants claim would appear vague and specifically how this is achieved to obtain their mesoporous film.

The terms “upper mole ratio” and “lower mole ratio” would appear vague and indefinite throughout the claims such as claim 41, 46, 50, and 60. Applicants may consider actual numerical ranges in their claims for their upper ratio and lower ratio to resolve this issue.

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The term "low k" dielectric film is indefinite because applicants do not define what is considered "low" dielectric constant. Applicants should supply a numerical range for what they consider "low" in their claim to resolve this issue.

The term "ration" should be ratio in claim 56 (d).

Claim 57 is indefinite because the final step of diluting with an alcohol is unclear. How much dilution is occurs (ie what amounts and what concentration). Applicants should supply these parameters to make this claim definite.

Surrender of US Patent

Applicants would appear to make the offer to surrender their original ribboned copy US patent for this re-issue application. In response, it is respectfully requested applicants actually submit the ribboned original US patent number 5,922,299 in their next response.

Citation of Applicable or Relevant Art

US Patent Number 5,858,457 to Brinker et al. has been cited of interest as relevant art to the instantly claimed invention.

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Reminder regarding supplemental oaths

Applicants are reminded that any further changes or errors corrected such as the first error regarding submission of product claims, these amendments must be accompanied by a proper oath or declaration prior to allowance stating "that each of these errors arose without any deceptive intention on the part of the applicant". (37 CFR 1.175(b)(1)). SEE MPEP 1444 for handling supplemental oaths and declarations and MPEP 1414.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703) 308-1196. If efforts to reach the examiner are unsuccessful, supervisory primary examiner Mark Bell may be reached at (703) 308-3823.



PAUL MARCANTONI
PRIMARY EXAMINER
GROUP 1700